

REMARKS

Response to Arguments

Claims 1-30, 32-40 and 43-76 remain in this application. Applicants note with appreciation the Examiner's acknowledgement that the arguments made by Applicants in Amendment A filed on 1 July 2005 have been deemed fully persuasive. The Examiner's concerns regarding the new grounds of rejection are addressed in detail below.

Information Disclosure Statement

Applicants acknowledge with appreciation the Examiner's consideration of the Information Disclosure Statement as submitted on 15 February 2002.

Regarding the 35 U.S.C. §102 Rejections over Mintz

In the outstanding Office Action, the Examiner rejected remaining Claims 1-13, 25-30, 32-40 and 73-76 under 35 U.S.C. §102(e) as being anticipated by Mintz (U.S. Pat. No. 6,250,930 B1; hereinafter, Mintz). In particular, regarding Claim 1, the Examiner asserts that Mintz discloses:

[I]n a multi-user e-mail messaging system interfaced through the Internet and including at least a first user group sharing at least a first server, which first server is, in turn, interfaced to the Internet such that any user of the first user group may send an e-mail message for transfer to an intended recipient selected as at least one of (i) another user in the first user group and (ii) a remote user interfaced to the Internet by a connection other than said first server (fig. 1 items 110, 120, and 125), a method comprising:

after said e-mail message has been originated by an originating user of the first user group, directing the e-mail message onto an e-mail enhancement path (column 4, lines 44-58);

adding additional rich media content to said e-mail message using the e-mail enhancement path to produce an enhanced e-mail message; and thereafter, directing the enhanced e-mail message from the e-mail enhancement path to the intended recipient (column 4, lines 44-58; column 5, lines 25-67).

Applicants respectfully disagree with the Examiner's assertion at least for reasons discussed immediately hereinafter.

To anticipate a claim, the reference must teach every element of the claim and "the identical invention must be shown in as complete detail as is contained in the ... claim." *MPEP 2131* citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).

Applicants respectfully submit that Mintz does not teach every element of Claim 1. The Examiner relies upon cited FIG. 1 process steps 110, 120 and 125 as well as column 4, lines 44-58 of Mintz for disclosure of the limitation of, after the e-mail message has been originated by an originating user of the first user group, directing the e-mail message onto an e-mail enhancement path. The Examiner further relies upon column 5, lines 25-67 of Mintz for disclosure of

adding rich media content to the e-mail message using the e-mail enhancement path. Applicants respectfully submit that FIG. 1 steps 110, 120 and 125, as well as column 4, lines 44-58, which describes these steps in FIG. 1, simply refer to the general process of enhanced e-mail message creation by a user, as will be further described immediately below.

Firstly, Mintz describes the entire creation of the "multimedia enhanced e-mail message" as being performed within step 120 using "the e-Logic Authoring and Editing Engine" (column 4 lines 48-49), which in turn is described in column 5, lines 25-67, followed by the use of a "Web command Launcher 125 to provide centralized control of multiple web-browser windows embedded within an enhanced e-mail message" (column 4, lines 51-53). That is, Mintz refers to an "enhanced e-mail message created at 120", thereby implying that the e-Logic Authoring and Editing Engine somehow creates the enhanced e-mail message. It appears to Applicants that the e-Logic Authoring and Editing Engine of Mintz is merely an authoring tool for realtime e-mail message composition by a user. While Mintz presents a list of the variety of functionalities allowed by the e-Logic Authoring and Editing Engine, Applicants respectfully submit that Mintz fails to specifically teach how such functionalities may be implemented. That is, while Mintz asserts, for example, that a "user can design, create or author such a multimedia e-mail message, questionnaire, and/or survey and send them to groups of people (numbering even in the millions) simultaneously", Mintz does not provide details on how such multimedia e-mail messages are generated. It is respectfully submitted that mere mention of a "multimedia enhanced e-mail message" does not constitute an enabling disclosure of the creation of such an enhanced message that is within the meaning of Claim 1. Furthermore, while Mintz states that "the e-Logic Authoring and Editing Engine uses the Web Command Launcher 125 to provide centralized control of multiple web-browser windows embedded within an enhanced e-mail message", the specifics of this Web Command Launcher are unclear in the disclosure of Mintz. It appears to Applicants that Web Command Launcher 125 is not a part of the enhanced e-mail message creation process since the enhanced e-mail message has already been created, in the disclosure of Mintz, in step 120.

Secondly, Applicants respectfully submit that FIG. 1 of Mintz, as cited by the Examiner, is a flow chart illustrating a method; that is, no physical "enhancement path" can be shown in FIG. 1 of Mintz. In contrast, the enhancement path, as recited in Claim 1, is clearly illustrated as a physical path within an e-mail message system in the present application as filed, for example, in FIG. 4. Therefore, it is respectfully submitted that the cited passages fail to meet the limitations as recited in Claim 1. As indicated in the present application (e.g., in FIG. 4 and in paragraphs [0070] and [0240] of the application as filed), the e-mail enhancement path in the present application refers to an outbound message routing path through which selective addition of rich media content is performed *after* a user generates the message content. The enhancement path of the present invention includes 1) a first process containing a routing application; and 2) a second process containing a processing application for selective addition of rich media content to outbound messages. In other words, Mintz states that the user creates an enhanced e-mail message in realtime using the e-Logic Authoring and Editing Engine. That is, Mintz asserts that the communication process "starts at 110 with a user creating an enhanced e-mail message". In contrast, Claim 1 provides that an originating user first generates an e-mail message without enhancements then, *after* the e-mail message has been originated by the originating user, this non-enhanced e-mail message is directed onto an e-mail enhancement path, where the rich media content may be added so as to create an enhanced e-mail message. As clearly illustrated, for example, in FIG. 4 of the present application as filed, the rich media content is *not* added at the user computer but at an enhancement path that is separate from the e-mail client that transmits outgoing messages. It is respectfully submitted that Mintz does not disclose or suggest in any way that communication of an e-mail message includes such function of the enhancement path for the selective addition of rich

media content, as provided in Claim 1. Therefore, in light of at least the above arguments, Applicants respectfully submit that Claim 1 overcomes the art of record.

Claims 2-13, 25-30 and 75 each depends either directly or indirectly from and therefore include the limitations of amended Claim 1. Accordingly, it is respectfully submitted that each of these claims is also patentable over the art of record for at least the reasons set forth above with respect to Claim 1. Further, each of these dependent claims places additional limitations on their parent and intermediate claims which, when considered in light of Claim 1, further distinguish the claimed invention from the art of record.

For example, Claim 2 provides that directing the e-mail message to the e-mail enhancement path includes receiving the e-mail message at the first server, which is shared by at least a first user group. Regarding Claim 2, the Examiner additionally states that Mintz also discloses:

directing the e-mail message onto the e-mail enhancement path includes receiving the e-mail message at said first server (column 6, lines 42-64).

Applicants respectfully disagree with the Examiner's statements for at least the following reasons.

The cited passage concerns the "e-Logic Communication Engine" and the translation of the "multimedia enhanced e-mail message", as created in step 120 of FIG. 1, into "a proprietary text-based format" and the sending of this translated message by a standard POP or IMAP server. In other words, this portion of the disclosure of Mintz refers to what happens to an enhanced e-mail message following its creation. In contrast, Claim 2 is concerned with the directing of a user-generated (non-enhanced) e-mail message onto an e-mail enhancement path *before* the addition of rich media content to the user-generated e-mail message. That is, the cited passage does not provide for the direction of the e-mail message to an e-mail enhancement path for the addition of additional content to an e-mail message in order to produce an enhanced e-mail message as described in the present application. Such a procedure is described in detail in the present application at, for example, paragraphs [0079], [0081] and [0240]. Therefore, Applicants respectfully submit that this cited passage does not disclose the limitations as provided in Claim 2.

As another example, Claim 6 provides for the e-mail the case where the e-mail message includes a header section, which contains information regarding the originating user and the intended recipient, and wherein altering the e-mail message includes separating and modifying the header section in a predetermined way. The Examiner additionally relies on column 7, lines 1-32 of Mintz, as teaching the limitations provided in Claim 6. While the cited passage mentions the use of "proprietary e-Logic headers" in the enhanced e-mail message, Applicants respectfully submit that there is no teaching in Mintz of what these "e-Logic headers" are specifically. That is, these e-Logic headers appear to function as an identifier for allowing the provision of filtering of the messages in a peer-to-peer system. Furthermore, although it is not clear from the disclosure of Mintz whether such "e-Logic headers" are appended to or substituted in place of the existing message headers at some point perhaps during the translation of the enhanced message into the aforementioned proprietary text format, Claim 6 recites the separation and modification of the message headers *before* the enhancement of the e-mail message with rich media content. Therefore, it is respectfully submitted that the art of record does not anticipate the limitations as recited in Claim 6.

As another example, Claim 7 provides for parsing and temporarily storing the originating user and intended recipient information in a designated file separate from the e-mail message. Such a procedure is described in the present application, for example, in paragraph [0174]. The Examiner asserts that Mintz discloses such a procedure in column 6, lines 42-64, and column 7, lines 1-32. Applicants respectfully traverse. As discussed earlier, the passage at column 6, lines 42-64 of Mintz refers to the translation of a pre-existing enhanced e-mail message into a proprietary text-based format, while the passage at column 7, lines 1-32 concerns the addition of "proprietary e-Logic headers" for distinguishing between "e-Logic messages" and standard e-mail messages. Specifically regarding headers, Mintz teaches the storage of *entire* messages that are identified by certain file extensions for filtering purposes:

When they are detected and received, messages of the .elo and .mm message types are stored for later viewing via the e-Logic mail viewer. Messages of the .elr format are relayed to the Aggregation Engine for processing and storage in appropriate databases. [Column 7, lines 18-19 of Mintz]

That is, Mintz does not teach or suggest in any way the temporary storage of only certain portions of the header, as provided in Claim 7.

As still another example, Claim 8 provides for inactivating the originating user and intended recipient information contained in the header, and adding an alternate header section containing active information regarding an alternate sender and an alternate message recipient. Such a procedure is described in the present application, for example, in FIG. 23 and paragraph [0134]. The Examiner states that Mintz teaches such a procedure in the previously cited column 6, lines 42-64, and column 7, lines 1-32. Applicants respectfully disagree with the Examiner's statement. In the cited passages, there is no mention of the addition of an *alternate* header section specifically containing active information regarding an alternate sender and an alternate message recipient. Therefore, Applicants respectfully submit that the art of record does not teach the present invention as recited in Claim 8.

As another example, Claim 9 provides for inactivating the information regarding the originating user and intended recipient contained in the header section by adding a predetermined prefix to the originating user and intended recipient information contained in the header section. Such a procedure is described in the present application, for example, in FIG. 11 and paragraph [0133]. The Examiner asserts that Mintz discloses such a procedure in the previously cited passages at column 6, lines 42-64, and column 7, lines 1-32. Applicants respectfully traverse. The passages cited by the Examiner are devoid of any teaching to *inactivating* certain portions of the header section, as provided by Claim 7. It is respectfully submitted that such a header modification using "proprietary e-Logic headers that are SMTP compliant" (column 7, lines 8-9 of Mintz) does not provide the inactivation of the header information regarding the originating user and intended recipient by adding a predetermined prefix to the originating user and intended recipient information, as provided by Claim 9.

As yet another example, Claim 13 provides for directing the e-mail message onto the e-mail enhancement path including adding a request for additional content to the e-mail message. The Examiner states that Mintz discloses such a procedure in column 6, lines 42-64. Applicants respectfully traverse. As discussed earlier, the passage at column 6, lines 42-64 of Mintz refers to the translation of an enhanced e-mail message, *after the enhanced message has been created*, into a proprietary text-based format. Applicants respectfully submit that nowhere does Mintz disclose the adding of a request for additional content (i.e., rich media as set forth in, for instance, paragraphs [0003] and [0078] of the present

application) to a given message in order to produce an enhanced message (e.g., as described in paragraph [0068] of the present application). It is respectfully submitted that the cited passages gives no mention of the addition of a request for additional content to produce an enhanced e-mail message, as provided by Claim 13 as amended.

Claim 32 is an independent claim including limitations similar to those of Claim 1, as discussed above. Therefore, it is respectfully submitted that the arguments present above regarding the allowability of Claim 1 over Mintz are also applicable to Claim 32. For at least these reasons, Applicants respectfully submit that amended Claim 32 overcomes the art of record.

Claims 33-34 and 76 each depends either directly or indirectly from and therefore include the limitations of amended claim 32. Accordingly, it is respectfully submitted that each of these claims is also patentable over the art of record for at least the reasons set forth above with respect to claim 32. Further, each of these dependent claims places additional limitations on their parent and intermediate claims which, when considered in light of claim 32, further distinguish the claimed invention from the art of record.

Claims 35 and 36 are independent claims including limitations similar to those of Claim 1, as discussed above. Therefore, it is respectfully submitted that the arguments present above regarding the allowability of Claim 1 over Mintz are also applicable to Claims 35 and 36. For at least these reasons, Applicants respectfully submit that Claims 35 and 36 overcome the art of record.

Claims 37 and 38 each depends either directly or indirectly from and therefore include the limitations of claim 36. Accordingly, it is respectfully submitted that each of these claims is also patentable over the art of record for at least the reasons set forth above with respect to claim 36. Further, each of these dependent claims places additional limitations on their parent and intermediate claims which, when considered in light of Claim 36, further distinguish the claimed invention from the art of record.

Claim 39 is an independent claim including limitations similar to those of Claim 1, as discussed above. Therefore, it is respectfully submitted that the arguments present above regarding the allowability of Claim 1 over Mintz are also applicable to Claim 39. For at least these reasons, Applicants respectfully submit that Claim 39 overcomes the art of record.

Claim 40 depends directly from and therefore includes the limitations of claim 39. Accordingly, it is respectfully submitted that each of these claims is also patentable over the art of record for at least the reasons set forth above with respect to claim 39. Further, each of these dependent claims places additional limitations on their parent and intermediate claims which, when considered in light of claim 39, further distinguish the claimed invention from the art of record.

Claims 73 and 74 are independent claims including limitations similar to those of Claim 1, as discussed above. Therefore, it is respectfully submitted that the arguments present above regarding the allowability of Claim 1 over Mintz are also applicable to Claims 73 and 74. For at least these reasons, Applicants respectfully submit that Claims 73 and 74 overcome the art of record.

Hence, it is respectfully submitted that all of remaining Claims 1-13, 25-30, 32-50 and 73-76 overcome the Examiner's 35 U.S.C. §102(e) rejections over Mintz. Therefore, Applicants respectfully request the passage of these Claims to allowance.

Regarding the 35 U.S.C. §103 Rejections over Mintz in view of Bereiter and Elliott et al.

In the outstanding Office Action, the Examiner rejected remaining Claims 14-24 and 43-72 under 35 U.S.C. §103(a) as being unpatentable over Mintz in view of Bereiter (U.S. Pat. No. 6,185,606 B1; hereinafter, Bereiter). Although the Examiner additionally cited Elliott et al. (U.S. Pat. No. 5,867,495; hereinafter, Elliott) within the context of these rejections, Elliott was not specifically mentioned in relation to any of the rejected remaining claims. Therefore, the following discussion of the 35 U.S.C. §103(a) rejections is focused on the combination of Mintz and Bereiter references only.

Specifically regarding Claim 14, the Examiner states that Mintz discloses the method of Claim 13, from which Claim 14 directly depends, but does not specifically disclose the validation of the request as provided in Claim 14. The Examiner further asserts that:

In the same field of endeavor, Bereiter discloses a method in which "... an automatic e-mail agent that receives incoming e-mail and triggers the activation of the attachment without human involvement. The e-mail agent would thus run as a background task and await input from either the point-to-point network connection of the e-mail subsystem. When an input was received, the agent would then validate and process the message for display ... [column 5, lines 22-29 of Bereiter] Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Bereiter's teachings of a method an [sic] validation of a request for additional rich media content, with the enhanced e-mail within an enhancement path teachings of Mintz ... [Office Action page 14]

Applicants respectfully disagree with the Examiner's assertion at least for reasons discussed immediately hereinafter.

Firstly, it is respectfully submitted that Bereiter is not in the same field of endeavor as Mintz. In particular, while Mintz is concerned with the creation and distribution of enhanced e-mail messages, Bereiter is solely concerned with so-called adaptive messaging for transmitting commands. Specifically, Bereiter mentions e-mail only as one alternative mode of communication between machines in a computer network when other modes of communication have failed. For example, in the Abstract, Bereiter states: "According to the invention, a communication from the server to the client may be "repackaged" in an e-mail message in the event a point-to-point connection between the server and the client cannot be established ...". Also, Bereiter appears to contain only one brief mention of validation and only in the context of processing a message for display, not for the enhancement of an e-mail message with rich media. Applicants respectfully submit that one of ordinary skill in the electronic messaging and rich media arts would not look to adaptive messaging as a related art. Therefore, it is respectfully submitted that Bereiter should not be considered to be in the same field of endeavor as Mintz.

Additionally, Claim 14 depends indirectly from and therefore includes the limitations of Claim 1. Accordingly, it is respectfully submitted that Claim 14 is not anticipated by Mintz alone for at least the reasons set forth above with respect to claim 1. That is, as discussed above, it is respectfully submitted that Mintz does not teach the use of an enhancement path *after* the generation of the original message (without enhancement), as provided in Claims 1 and 13, from which Claim 14 depends. Furthermore, Claim 14 recites that adding the request for additional rich media content to the e-mail message includes providing a validation of the request such that the additional rich media content is added to the e-mail message responsive to the validation. While Bereiter mentions the validation of a message, it is unclear in Bereiter what is exactly meant by "validate" since this word is used only once in the specification of Bereiter. For at least these reasons, Applicants respectfully submit that the combination of the art of record does not provide the totality of the features claimed in Claim 14.

Claims 15-24 each depends either directly or indirectly from and therefore include the limitations of Claim 14. Therefore, it is respectfully submitted that the arguments present above regarding the allowability of Claim 14 over Mintz in view of Bereiter are also applicable to Claims 15-24 at least to the extent that these dependent claims reflect the limitations of Claim 14. For at least these reasons, Applicants respectfully submit that Claims 15-24 overcome the art of record in any reasonable combination. Further, each of these dependent claims places additional limitations on their parent and intermediate claims which, when considered in light of Claim 14, further distinguish the claimed invention from the combination of the art of record.

For example, Claim 15 recites adding the request for additional rich media content further includes inserting one or more reference tags into the e-mail message. The Examiner states that Bereiter discloses such reference tags in column 3, lines 50-61. It is respectfully submitted that the cited passage refers to the identification of network communication endpoints using a *universally unique reference* (UUR), which identifies network addresses and e-mail addresses and are different from reference tags *within an e-mail message*, as provided in Claim 15.

As another example, the Examiner states that the validation of the request for additional rich media by assigning a set of rules for the validation and generating the validation according to these rules, as recited in Claim 16, is disclosed in the combination of Mintz and Bereiter, particularly in the previously cited column 3, lines 50-61 of Bereiter. The cited passage of Bereiter refers to the validation of connectivity with a given machine by attempting a point-to-point connection; that is, the cited passage does not disclose or suggest in any way the validation of a request for addition of rich media in accordance with a set of rules.

Claims 43-62, 64, 66, 68, 70 and 72 are independent claims including limitations that reflect those of Claim 1. Therefore, the arguments above regarding the §102(e) rejection of Claim 1 are applicable to Claims 43-62, 64, 66, 68, 70 and 72 in view of Mintz, it is respectfully submitted that all of the elements recited in Claims 43-62, 64, 66, 68, 70 and 72 are not found in Mintz alone. Moreover, the cited passage of Bereiter adds nothing to the teachings of Mintz regarding the features as claimed in 43-62, 64, 66, 68, 70 and 72. Therefore, Applicants respectfully submit that Claims as recited in 43-62, 64, 66, 68, 70 and 72 overcome the combination of the art of record.

Claim 65 depends directly from and therefore includes the limitations of amended claim 64. Accordingly, it is respectfully submitted that each of these claims is also patentable over the art of record for at least the reasons set forth above with respect to claim 64. Further, each of these dependent claims places additional limitations on their parent and

intermediate claims which, when considered in light of claim 64, further distinguish the claimed invention from the art of record.

Claim 69 depends directly from and therefore includes the limitations of claim 68. Accordingly, it is respectfully submitted that this claim is also patentable over the art of record for at least the reasons set forth above with respect to claim 69. Further, this dependent claim places additional limitations on its parent and intermediate claims which, when considered in light of claim 68, further distinguish the claimed invention from the art of record.

Claim 70, as amended, is an independent claim including limitations similar to those of amended Claim 43, as discussed above. Therefore, it is respectfully submitted that the arguments present above regarding the allowability of Claim 43 over Mintz in view of Bereiter are also applicable to Claim 70. For at least these reasons, Applicants respectfully submit that amended Claim 70 overcomes the combination of art of record.

Claim 71 depends directly from and therefore includes the limitations of amended claim 70. Accordingly, it is respectfully submitted that each of these claims is also patentable over the art of record for at least the reasons set forth above with respect to claim 70. Further, each of these dependent claims places additional limitations on their parent and intermediate claims which, when considered in light of claim 70, further distinguish the claimed invention from the art of record.

Claim 72, as amended, is an independent claim including limitations similar to those of amended Claim 43, as discussed above. Therefore, it is respectfully submitted that the arguments present above regarding the allowability of Claim 43 over Mintz in view of Bereiter are also applicable to Claim 72. For at least these reasons, Applicants respectfully submit that amended Claim 72 overcomes the combination of art of record.


Regarding amended Claims 28 and 29, it is noted that these claims depend indirectly from amended claim 1. Initially, it is submitted that Bereiter contributes nothing to the rejection of claim 1 under section 102, as discussed above. Further, it is submitted that claims 28 and 29 place additional limitations on their parent and intermediate claims which further distinguish these claims over the art of record.

Conclusion

Consequently, it is respectfully submitted that all of the Examiner's objections regarding the remaining claims have been overcome and that the application is in condition for allowance. Hence, allowance of these remaining claims and passage to issue of the application are solicited.

If the Examiner has any questions concerning this case, the Examiner is respectfully requested to contact Michael Pritzkau at 303-410-9254.

Respectfully submitted,


Michael M. Pritzkau
Reg. No. 37,913